

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STANLEY W. STEPHENSON III

Appeal No. 97-3400
Application 08/584,908¹

ON BRIEF

Before COHEN, ABRAMS and STAAB, *Administrative Patent Judges*.

STAAB, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 1, 3 and 5-7. Claim 2 has been canceled. Claim 4, the only other claim pending in the application, has been finally rejected but not appealed.² Accordingly, the final rejection of

¹ Application for patent filed January 11, 1996.

² See Notice of Appeal (Paper No. 10).

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claim 4 is not before us. An amendment filed subsequent to the final rejection correcting a typographical error in claim 1 has been entered.

Appellant's invention pertains to an index print sheet on which is printed a series of pictures that match a series of images recorded on a film medium, with the index print sheet being capable of storing or holding the film medium. Independent claim 5, a copy of which is appended to appellant's brief, is illustrative of the appealed subject matter.³

The references of record relied upon by the examiner in support of a rejection under 35 U.S.C. § 103 are:

Lowenstein	1,233,076	Jul. 10, 1917
Holson	4,263,357	Apr. 21, 1981

In addition, the examiner relies upon Official Notice, explained below, in support of the rejection.

Claims 1, 3 and 5-7 stand rejected under 35 U.S.C. § 103 as being unpatentable over "Official Notice in view of Holson and Lowenstein" (answer, page 3).

Considering first independent claim 5, this claim is directed to a film package comprising a film sheet and an index

³ The copy of the appealed claims appended to appellant's brief is incorrect in that line 1 of claim 3 should read ". . . as recited in claim 1"

print sheet. The film sheet has a series of images recorded on one side and a non-image area on the same side. The index print sheet has a series of pictures on one side and a non-picture area on the same side. According to the claim, the pictures on the index print sheet "match the series of images recorded on said film sheet" and the non-picture area of the index print sheet is "in the same relative location as said non-image area on the film sheet and [is] sized to permit the film sheet to be placed over said non-picture area without covering any of the pictures." In addition, the index print sheet is provided with holding means for releasably securing the film sheet to the non-picture area of the index print sheet. Thus, it is clear that the picture and non-picture areas on the claimed index print sheet and the image and non-image areas on the claimed film sheet are positively related to each other.

In rejecting this claim, the examiner has taken Official Notice "that it is conventional to display photographs, film negatives, transparent strips, or positive images in a transparent photographic album with pockets" (answer, pages 3-4).⁴ The examiner has also found that "Holson teaches providing

⁴ Appellant has not challenged the examiner's taking of Official Notice to the extent quoted.

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a photographic album page comprising multiple pockets for retaining pictures thereon" and that "Lowenstein teaches providing a carrier 10 with retaining strips forming a pocket for holding a removable transparent strip" (answer, page 4).

Based on these findings, the examiner has made the following conclusions of obviousness:

It would have been obvious . . . to store film in a desired location on a conventional picture storing album sheet in an arrangement with the photographs. To have provided the film in any desired location with respect to the photographs . . . would further have been obvious, for a purpose such as to facilitate identification of the desired negatives for further processing. No patentable or unobvious distinction is seen between associating negatives with a plurality of individual prints or with a contact sheet made from those negatives. These are old and conventional practices in the art of storing photographic negatives. [Answer, page 4.]

We agree with appellant, however, that the examiner's taking of Official Notice that it is conventional to insert pictures or negatives into transparent album pockets, in combination with the teachings of Holson and Lowenstein, would not have suggested to the ordinarily skilled artisan the claim requirement of providing picture bearing index print sheet having a non-picture area in the same relative location on the index print sheet as a non-image area on the film sheet. In particular, Lowenstein, which we view as the more pertinent of the applied references, is not

seen as providing any such suggestion. Lowenstein pertains to a classification and indexing system for motion pictures, the main component of which is an article which carries a series of chronologically non-consecutive views occurring on a particular motion picture film. Holson's disclosure, insofar as pertinent, is nothing more a photo album page having a plurality of pockets for receiving pictures. From our perspective, what is lacking in the examiner's evidentiary basis is any teaching of laying out the picture and non-picture areas on an index print sheet in the same relative locations as the image and non-image areas on the film sheet.

We also must disagree with the examiner to the extent he contends that the claimed relationship between the areas on the film and index print sheet is of no patentable moment. The examiner has failed to indicate any teaching in the applied references or any prior knowledge generally available to one of ordinary skill in the art that would have led an ordinarily skilled artisan to provide a film sheet and an index print sheet in accordance with the requirements of claim 5. In short, the rejection of appealed claim 5 must fail for lack of a sufficient factual basis. *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968).

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We shall therefore not sustain the standing § 103 rejection of claim 5, or claims 6 and 7 which depend therefrom.

Turning to independent claim 1, in asserting the patentability of this claim, appellant argues on page 6 of the brief that claim 1

is patentable for the same reason that Claim 5 is patentable. Specifically, Claim 1 calls for a picture-bearing index print sheet where a non-picture area is in the same relative location on the picture-side of the index print sheet as the non-image area is on a film medium to be held on the index print sheet.

This argument is not well taken. As appellant acknowledges, claim 1 differs from claim 5 in that claim 1 is directed to a film storing sheet comprising an index print sheet *per se*. While we appreciate that claim 1 includes terminology relating the picture and non-picture areas of the index print sheet to image and non-image areas on an inferentially recited film medium, and that this terminology must be considered in determining the patentability of the claim, the film medium is *not* a positively recited part of the claimed subject matter.

As noted above, the main component of Lowenstein's motion picture classification and indexing system is an article which carries a series of chronologically non-consecutive views occurring on a particular motion picture film. Figures 1 and 2

constitute two such examples of this article. In Figure 1, the article is in the form of an card or sheet carrying a series of characteristic non-consecutive scenes of the film (page 2, lines 13-21). The card further includes an area at the top of the card or sheet for cataloging information, which may include a pocket "for holding in place a removable transparent strip 11^a carrying dates or other variable matter" (page 2, lines 36-39). The alternative article shown in Figure 2 comprises a short section of ordinary motion picture film strip upon which non-consecutive views from a particular motion picture film have been reproduced (page 2, lines 70-73).

Relating the Figure 1 article of Lowenstein to claim 1, we find that Lowenstein's Figure 1 article comprises an index print sheet 10 having a series of pictures printed on one side thereof (see page 2, lines 103-112), and an upper non-picture area including a holding means in the form of a pocket 11 which is fully capable of releasably securing an appropriately sized film medium to the sheet. Regarding the terminology appearing in the preamble and body of the claim relating the picture and non-picture areas of the print index sheet to an inferentially recited film medium, Lowenstein's print sheet meets this claim terminology in that the arrangement of picture and non-picture

areas of Lowenstein's Figure 1 sheet is as called for in the claim for an appropriately sized film medium having an appropriately arranged series of images recorded thereon.

For the reasons discussed above, claim 1 lacks novelty over Lowenstein's Figure 1 article. While we appreciate that the examiner has expressed the rejection in terms of obviousness, we note that evidence establishing lack of novelty in the claimed invention necessarily evidences obviousness. Lack of novelty has been characterized by one of the predecessors of our court of review as being the ultimate or epitome of obviousness. See *In re Fracalossi*, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982) and *In re Pearson*, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974). We therefore shall sustain the examiner's rejection of claim 1 under § 103, noting that Holson and the examiner's taking of Official Notice are cumulative.

We will also sustain the rejection of dependent claim 3 since appellant acknowledges on page 4 of the brief that this claim stands or falls with claim 1.

In summary, the standing § 103 rejection of claims 1, 3 and 5-7 is reversed as to claim 5-7 but is affirmed as to claims 1 and 3.

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The decision of the examiner is affirmed-in-part.

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED-IN-PART

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
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